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EXAMINER

FOSTER, ROLAND G

ART UNIT

PAPER NUMBER

2645

DATE MAILED: 04/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/027,003

Applicant(s)

BOSIK ET AL.

Examiner

Roland G. Foster

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13-24 is/are allowed.
- 6) ☒ Claim(s) 1-7, 11 and 12 is/are rejected.
- 7) ☒ Claim(s) 8-10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2645

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 5, and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S.

Patent No. 6,038,451 to Syed et al. (hereinafter "Syed").

With respect to claim 1, see the following paragraphs for details on how Syed discloses particular limitations within the claim. Limitations not addressed are clearly disclosed by Syed.

The limitation "(a) determining a forwarding location...using a mobile location technology...using service provider equipment" reads on Syed as follows. Network location finding system 25 (service provider equipment) uses mobile technology (such as cell granularity determination or 911 cellular location technology) to determine the location of the mobile telephone (abstract and col. 3, line 59 – col. 4, line 9). The location is determined to be a forwarding location to a wireline telephone number (col. 4, lines 38-55).

The limitation "(b) providing the landline telephone number of the landline telephone to the service provider" clearly reads on col. 4, lines 38-55.

The limitation "(c) determining a current mobile telephone location of the mobile telephone by the mobile location technology" reads on col. 4, lines 20-37 where the current location of the mobile telephone is determined using mobile technology as discussed above.

The limitation "(d) determining whether the call is being made to the mobile telephone when the current mobile telephone location is approximately at the forwarding location" clearly reads on col. 4, lines 37-55.

The limitation "(e) forwarding the call....to the landline telephone number....when the current mobile telephone location is approximately at the forwarding location" clearly reads on col. 4, lines 51-55.

With respect to claim 2, the system (captures) the last known location of the mobile telephone (col. 4, lines 20-37), which certainly includes situations where the telephone is powered off and the known location becomes the last known location.

With respect to claim 5, the step of determining the forwarding location can be considered as the broadly recited "initialization step."

With respect to claim 6, see col. 3, lines 40-50.

Art Unit: 2645

Claims 1 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,233,448 B1 to Alperovich et al. (hereinafter "Alperovich").

With respect to claim 1, Alperovich is similar to Syed as discussed in detail above, thus it should be clear how Alperovich reads on all the limitations within the claim. For example, see the abstract, Figs. 1 and 2, and col. 5, lines 1-20.

With respect to claim 11, see col. 3, lines 29-52.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit: 2645

Claims 3, 4, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Syed as applied to claims 1 and 2 above.

With respect to claims 3 and 4, Syed discloses all within the claims (including the forwarding location of the voicemail being different from the last known location, e.g., see col. 3, lines 40-50) except determining whether the call is being made to the telephone when the telephone is powered off.

With respect to claim 7, Syed discloses forwarding to a voicemail system (col. 3, lines 40-50) but fails to disclose forwarding when the call is unanswered after a predetermined period of time.

However, "Official Notice" is taken that both the concept and advantages of telephone system that, during the course of placing a call to a mobile telephone, determines that the telephone is powered off and that forwards the call when unanswered after a predetermined period of time would have been well-known and expected in the art.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add determination that the mobile telephone is powered off and forwarding to voicemail when the mobile is unanswered after a predetermined period of time to the mobile telephone system of Syed.

Art Unit: 2645

The suggestion/motivation for doing so would have been to increase the efficiency of the mobile telephone network by avoiding the attempt to place a call to powered off mobile telephone or to indefinitely ring a telephone that has not answered as is notoriously well known in the art of mobile telephone and voice mail systems.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Syed as applied to claim 1 above, and further in view of U.S. Patent No. 5,933,488 to Marcus et al. (hereinafter "Marcus").

Syed fails to disclose requiring the user to enter a personal identification number ("PIN") when the telephone is answered and before the call can be completed to the landline telephone.

However, Marcus (similarly to Syed) teaches of a system for forwarding a call to a landline telephone located in the same area of the subscriber (abstract) and where the subscriber (user) is required to enter PIN before the call can be completed (abstract and col. 6, lines 30-46).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add a requirement for the user to enter a PIN before the call can be completed at the landline telephone as taught by the location based, call forwarding system of Marcus to the location based, call forwarding system of Syed.

Art Unit: 2645

The suggestion/motivation for doing so would have been to increase security and privacy (Marcus, abstract and col. 1, lines 38-45).

Allowable Subject Matter

Claims 13-24 are allowed.

Claims 8-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Examiner's Reasons for Indicating Allowable Subject Matter

Independent claim 13 is similar to claim 1 as rejected above except claim 13 recites additional features directed to: 1) placing the call to the mobile telephone number and simultaneously forwarding the call from the mobile telephone to the landline telephone number, and 2) connecting the call to one of either the mobile telephone number or the landline telephone when the mobile telephone number is answered or the landline telephone number is answered, respectively, and terminating the call to either the mobile telephone number or the landline telephone number that is unanswered.

The closest prior art of record is Syed as discussed above. Syed discloses forwarding the call to a landline number but fails to disclose the simultaneously forwarding the call to the

Art Unit: 2645

landline number while placing the call to the mobile telephone number (first feature) and then the detailed alternate answer and termination process as recited in the second feature.

The remaining prior art or record fails to teach or suggest the obviousness of substantially modifying Syed in order arrive at the invention as claimed in detail by the applicant.

Claims 8-10 recite detailed algorithmic methods for determining location using mobile location that Syed fails to disclose. The prior art of record fails to teach or fairly suggest disclose substantially modifying Syed by adding detailed location algorithms in order to arrive at the invention as claimed.

The above reasons for allowance are based on the claims as presently set forth in their totality. The above reasons for allowance should not be interpreted as indicating that amended claims broadly reciting certain limitations discussed in the above reasons for allowance would be allowable. A more detailed reasons for allowance may be set forth in a subsequent Notice of Allowance if and when all claims in the application are put into a condition for allowance.


Art Unit: 2645

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roland Foster whose telephone number is (703) 305-1491. The examiner can normally be reached on Monday through Friday from 9:00 a.m. to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan S. Tsang, can be reached on (703) 305-4895. The fax phone number for this group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to customer service whose telephone number is (703) 306-0377.



Roland G. Foster
Primary Patent Examiner
April 2, 2004